

REMARKS

In the Office Action mailed January 12, 2010, the Examiner rejected claims 1-17 and 25-60 under §112, second paragraph for purportedly being indefinite.

Claims 1-3, 5-8, 13-17, 25, 26, 29-32, 40, 41, 43, 46, and 51-60 were rejected under §102 for alleged anticipation by US Patent 6,605,365 to Krienke et al.

Claims 9, 10, 33-36, 42, and 44-51 were rejected under §103 for alleged obviousness based upon Krienke et al.

Claims 4, 13, 27, 28, and 38-41 were rejected under §103 for alleged obviousness based upon Krienke et al. in view of WO 01/85854 to Clerici et al.

Claims 12 and 37 were rejected under §103 for alleged obviousness based upon Krienke et al. in view of US Patent 4,741,778 to Horie et al.

Claims 11 and 12 were rejected under §103 for alleged obviousness based upon Krienke et al. in view of US Patent 6,303,229 to Takahama et al.

In this response, claims 1-16 and 24-58 have been cancelled, clarifying amendments are presented to claims 17 and 59-60, and new claims 71-110 are presented. Claims 18-23 and 61-70 were previously withdrawn. In view of the explanations and amendments set forth herein, it is respectfully submitted that claims 17, 59, 60, and 71-110 are in condition for allowance.

A. Rejection of Claims 1-17 and 25-60 Under §112, Second Paragraph Should be Withdrawn

Specific concerns were expressed over claims 1, 14, and 15. Since those claims have been cancelled, it is believed that the noted concerns are now moot. One of the concerns expressed over claims 1 and 14 is believed to apply to claim 17.

It is respectfully submitted that upon consideration of the following, the Examiner will appreciate that claim 17 and claims 59-60 dependent therefrom are sufficiently definite, such that the rejection should be withdrawn. The recitations in claim 17 that (i) "at least one of an organic titanate and an organic zirconate in an amount from 0.3 to 24%" and (ii) "a silane-based binder in an amount from 1 to 25%" are both subject to a controlling requirement that (iii) "the sum of the organic titanate and/or zirconate and of the silane-based binder is between 5 and 25%." Restated, the sum of (i) and (ii) must be between 5 and 25%. Thus, once a total amount of those agents is identified (between 5 and 25%), then the apportionment of those agents is subject to the recitations (i) and (ii). For example, for a total amount of 5% of (iii) the agents, the amount of (i) the titanate and/or zirconate is 0.3% to 4%, and the amount of (ii) the silane-based binder is 1% to 4.7%. Conversely, for example, for a maximum amount of 25% of (iii) the agents, the amount of (i) the titanate and/or zirconate is from 0.3% to 24%, and the amount of (ii) the silane-based binder is an amount to total to 25%, i.e. 1% to 24.7%.

Accordingly, it is respectfully submitted that in view of the foregoing, the present rejection should be withdrawn.

B. Rejection of Claims 1-3, 5-8, 13-17, 25, 26, 29-32, 40, 41, 43, 46, and 51-60 Under §102 Should be Withdrawn

In view of the cancellation of claims 1-16 and 24-58 and withdrawal of claims 18-23, the rejection of claims 1-3, 5-8, 13-16, 25, 26, 29-32, 40, 41, 43, 46, and 51-58 is moot. The rejection of claims 17, 59, and 60 is addressed as follows.

Claim 17 has been amended to specifically recite that the claimed coated metallic substrate is formed in part, by "subjecting the coating layer to a baking operation at a temperature of between 180°C and 350°C by a supply of thermal energy to thereby form the anticorrosion coating."

US Patent 6,605,365 to Krienke et al. was relied upon for the present rejection under §102. A reading of that patent however reveals that the disclosed coatings are formed by a drying process, and only heated to a temperature in the range of 160°F to 250°F, see col. 26, lines 36-39. The '365 patent entirely fails to disclose subjecting the coating to a "baking operation" as recited in claim 17. Furthermore, the '365 patent entirely fails to disclose baking at a temperature between "180°C and 350°C" as recited in claim 17. The highest temperature disclosed by Krienke et al. is 250°F which is about 121°C.

Therefore, the '365 patent to Krienke et al. fails to disclose the subject matter of claim 17, as amended herein. For at least these reasons, it will be appreciated that the present rejection under §102 must be withdrawn.

Furthermore, another reason requiring withdrawal of the present rejection is as follows. Accompanying this response is a Declaration submitted by the inventor in the present application. As explained therein, subjecting the claimed coating composition to a baking operation at a temperature of between 180°C and 350°C produces an organo-mineral tridimensional structure, which as further explained in the Declaration, would not result from merely drying the coatings described in the '365 patent at temperatures of only 160°F to 250°F (i.e. 71°C to 121°C). The accompanying Declaration further supports the patentability of the claimed subject matter.¹

Since claim 17 is not anticipated by the '365 patent, then neither are any of claims 59 and 60 which depend therefrom.

Accordingly, it is submitted that the present rejection under §102 be withdrawn.

C. Rejection of Claims 9, 10, 33-36, 42, and 44-51 Under §103 Should be Withdrawn

All of these claims have been cancelled and so their rejection is moot.

¹ Applicant's attorneys are mindful of §2113 of the MPEP concerning the patentability of product-by-process claims. The enclosed Declaration is evidence as to the differences between the structures of the claimed coatings produced by high temperature baking as compared to the coatings of Krienke et al. which are formed by low temperature drying.

D. Rejection of Claims 4, 13, 27, 28, and 38-41 Under §103 Should be Withdrawn

All of these claims have been cancelled and so their rejection is moot.

E. Rejection of Claims 12 and 37 Under §103 Should be Withdrawn

All of these claims have been cancelled and so their rejection is moot.

F. Rejection of Claims 11 and 12 Under §103 Should be Withdrawn

All of these claims have been cancelled and so their rejection is moot.

G. New Claims 71-110

New claims 71-110 are presented herein for the Examiner's consideration.

These claims are all dependent or ultimately dependent from independent claim 17. No new matter is added by any of these claims since support is found throughout the present application as originally filed.

H. Conclusion

In view of the foregoing, it is respectfully submitted that all claims 17, 59, 60, and 71-110 are patentable over the cited art and in condition for allowance.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. CRE-17903.

Respectfully submitted,

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